



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. None

Stephen M. De Klerk
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles CA 90025

COPY MAILED

OCT 07 2004

OFFICE OF PETITIONS

In re Application of
Gek Hoon Quat et al.
Application No. 10/734,710
Filing Date: December 12, 2003
Attorney Docket No. 006404.P013
Title: CONNECTION FOR AUDIO
TRANSFER

DECISION ON RENEWED
PETITION UNDER 37 C.F.R. §1.182

Background

This is a decision on the renewed petition under 37 C.F.R. §1.182, filed July 27, 2004, requesting that the above-identified application be accorded a filing date of December 12, 2003, with the specification submitted with the instant petition as part of the original disclosure of the application.

The application was deposited on December 12, 2003. However, on March 30, 2004, the Office of Initial Patent Examination (OIPE) mailed a "Notice of Incomplete Nonprovisional Application – Filing Date Not Granted" (notice) stating that the application had NOT been accorded a filing date, and advising applicants that the application was deposited without a specification. The notice further indicated that a filing date would be accorded when a specification was received.

On April 12, 2004, the original petition was filed, along with a five page specification, four pages of claims, a one page abstract, and a copy of applicants' postcard receipt acknowledging receipt of "Application – Utility (10 pgs., with cover and abstract)" in the United States Patent and Trademark Office (Office) on December 12, 2003. Applicants request that both the application and the specification submitted with the instant petition be accorded a filing date of December 12, 2003.

Procedural History

The original petition was dismissed via the mailing of a decision on July 2, 2004. The decision set forth that the evidence was convincing that an 8 page specification, a 1 page abstract, and a 1 page cover sheet were deposited on December 12, 2003, however:

Unfortunately, the specification which Petitioner has submitted with the instant petition does not match the information which he placed on his postcard. Petitioner's postcard itemizes a 10 page specification including an abstract and a cover sheet. Petitioner has submitted a 5 page specification, 4 pages of claims, and a 1 page abstract, which totals ten pages. No cover sheet has been submitted. Hence, if Petitioner were to add a cover sheet onto that which he has submitted with the instant petition, the total number of pages would be 11. It appears that Petitioner has added an extra page to the present submission.

Decision on the Original Petition, page 2.

The Relevant Portion of the MPEP

Section 503 of the MPEP, entitled Application Number and Filing Receipt, sets forth, in part:

RETURN POSTCARD

If a receipt of any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted. If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application).

The postcard receipt will not serve as prima facie evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as prima facie evidence of receipt of those items.

The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the postcard initialed by the person receiving the items.

Upon return of a postcard receipt from the USPTO, the postcard receipt should be promptly reviewed by the person who filed the items to ensure that every item specifically denoted on the postcard was received by the USPTO. If the postcard receipt has been annotated to indicate that a particular item denoted on the postcard was not received by the USPTO, the postcard receipt will not serve as prima facie evidence of receipt of that item in the USPTO.

Analysis and Conclusion

With the renewed petition, Petitioner has asserted that only 5 pages of specification, 4 pages of claims, and a 1 page abstract were submitted on filing. As such, Petitioner states that no cover sheet was included on filing, the postcard Petitioner submitted was not accurate, and that "the

words 'cover and' as shown on the postcard...should therefore have been deleted¹." Petitioner adds that his firm has previously "submitted applications without cover sheets accompanied by the same postcard many times in the past, and has never experienced either an application gone missing or been questioned about this discrepancy before²."

Regarding the contents of the postcard, since the Petitioner has set forth that the postcard does not contain correct information, the Office has no way of knowing what was submitted to the Office on filing. However, since the postcard states that 10 pages were submitted, and Petitioner has attested over his registration number that the 5 pages of specification, 4 pages of claims, and the 1 page abstract are exact copies of that which was submitted on filing, the Office must grant this petition.

As such, the petition is **GRANTED**.

Regarding Petitioner's attestation that his firm places false information on its postcards as a routine matter of course, Petitioner is advised to refrain from engaging in this practice in the future, so as to avoid encountering a similar situation down the road.

The application file is being returned to the Office of Initial Patent Examination for further processing with a filing date of December 12, 2003, using 5 the pages of specification, 4 pages of claims, and the 1 page abstract submitted with the original petition on April 12, 2004.

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.



Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

¹ Renewed petition, page 3, paragraph number 6.

² Id.